

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hae Y. Kim

Art Unit: 3629

Application No: 10/715,137

Examiner: C. D. Carter

Confirmation No: 1911

Filed: November 18, 2003

Atty. Docket No: 29239-190105

For: SYSTEM AND METHOD FOR PLANNING
AND TRACKING CERTIFICATION PLANS

Customer No:

26694
PATENT TRADEMARK OFFICE

APPEAL BRIEF UNDER 37 C.F.R. §41.37

MS Appeal Brief - Patents
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

This is an appeal pursuant to 35 U.S.C. §134 from the Examiner's decision rejecting claims 1-13 and 15-18, as set forth in the Official Action of December 9, 2008. This Appeal Brief, is filed under the standards of current 37 C.F.R. §41.37, effective September 13, 2004. Appellant notes that the effective date of the June 10, 2008 revisions to 37 C.F.R. §41.37 has been delayed, as indicated in the Federal Register, v.73, n. 238, December 10, 2008, p. 74972. As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on April 9, 2009, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying Transmittal of Appeal Brief. The Commissioner is further authorized to charge any additional amount deemed due and to refund any amount deemed overpaid to Deposit Account No. 22-0261, under attorney-docket No. 29239-190105, with notification to the undersigned.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

- I. Real Party in Interest
- II Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be reviewed on Appeal
- VII. Argument
- VIII. Claims
- IX Conclusion
- Appendix A Claims
- Appendix B Evidence
- Appendix C Related Proceedings

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is Laureate Education Inc., Assignees of the inventor's entire interest.

II. RELATED APPEALS AND INTERFERENCES

No appeal or interference is known to Appellant, the Appellant's legal representative, or the Assignee that would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

1. Total Number of Claims in Application.

There are 17 claims pending in application.

2. Current Status of Application.

Claims canceled: 14.

Claims withdrawn from consideration but not canceled: None.

Claims pending: 1-13 and 15-18.

Claims allowed: None.

Claims rejected: 1-13 and 15-18.

3. Claims on Appeal

The claims on appeal are claims 1-13 and 15-18.

IV. STATUS OF AMENDMENTS

Applicant filed an Amendment on March 9, 2009 in response to the Official Action dated December 9, 2008 (the Official Action). The Examiner responded to the amendments made in an Advisory Action mailed March 19, 2009 (the Advisory Action). In the Advisory Action, the Examiner indicated that Applicants' amendments to claims 1, 5-13, 15, 16 and 18 would be entered. The references to the rejections set forth in the Official Action and reaffirmed in the Advisory Action after the entry of the amendments would be referred to herein in terms of both actions as Official/Advisory Action.

The claims enclosed herein as Appendix A incorporate the amendments to claims 1, 5-13, 15, 16 and 18 indicated in the paper filed by Applicant on March 9, 2009.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The sole independent claim 1 recites the following; corresponding information in the Figures and in the written description is indicated in parentheses.

Claim 1: A system accessible by at least one user over a computer network (*Paragraphs 1, 31-32, 38-39 and 41; Figure 1*) for planning and tracking certification (*Passim; Figures 2 and 4*), comprising:

a database (*Paragraphs 34, 56; Figure 5*) storing at least one user profile (*Paragraphs 9, 42 and 43; Figures 5, 8, 13 and 16*) and at least one authority profile (*Paragraphs 9, 42, 47, 52 and 57; Figures 5, 8, 13 and 16*), wherein the at least one user profile specifies user information (*Paragraphs 46-47, 54, and 56-57; Figures 8-10*) including a certification authority (*Paragraph 46; Figure 8*), and wherein the at least one authority profile contains one or more certification requirements (*Paragraph 47; Figures 8 and 11*) associated with the certification authority specified in the user profile;

a planning module (*Paragraph 39; Figure 2*) executed at one or more workstations (*Paragraph 32; Figures 1-2*) that generates one or more certification goals (*Paragraphs 43-44 and 47-51; Figure 8*) based on the at least one user profile and the at least one authority profile, wherein the planning module responds to the at least one user's selection of the one or more certification goals (*Paragraph 51; Figures 7-8*) to create a certification plan (*Paragraph 51; Figures 2, 8 and 9*) and wherein the planning module transmits the certification plan to the certification authority specified in the user profile (*Paragraph 72; Figure 14*); and

a tracking module (*Paragraph 39; Figure 2*) executed at one or more workstations (*Paragraph 32; Figures 1-2*) that updates the certification plan in response to input regarding achievement of the one or more user-selected certification goals (*Paragraphs 45, 69-70, 72 and 75; Figures 12 and 14*).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection for review are the following:

A. The rejection of claims 1-18 under 35 U.S.C. §101 as being directed to non-statutory subject matter, as presented in item 3 of the Official Action.

B. The rejection of claims 1-7, 9-11, 13 and 14 under 35 U.S.C. §103(a)¹ as being unpatentable over U.S. Application Publication No. 2003/0233242 to Wenger (Wegner) in view of U.S. Patent No. 6,606,480 to L'Allier et al. (L'Allier), as presented in item 6 of the Official Action.

C. The rejection of claims 8, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Wenger in view of L'Allier and in further view of U.S. Application Publication No. 2003/0046265 to Orton et al., as presented in item 7 of the Official Action.

D. The rejection of claims 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Wenger in view of L'Allier and in further view of Finaid.org (2002), as presented in item 8 of the Official Action.

¹ Item 6 of the Official Action cites 35 U.S.C. 102(e) for this rejection. However, because the Official Action applies two prior art references and an obviousness analysis in rejecting the claims, the Appellant assumes, as reflected throughout this Appeal Brief, that the cited rejection of Claims 1-7, 9-11, 13 and 14 is actually under 35 U.S.C. 103(a).

E. The rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Wenger in view of L'Allier and in further view of Examiner's Official Notice, as presented in item 9 of the Official Action.

VII. ARGUMENT

A. The rejection of claims 1-18 as being directed to non-statutory subject matter.

Claims 1-13 and 15-18 stand rejected under 35 U.S.C. §101 as being directed toward a system for planning or tracking certification comprising a planner and a tracker which is not recited as having any corresponding structure in the specification and given its broadest reasonable interpretation can be construed as nothing more than software. (See, Official Action, item 4) In view of amended claim 1, Appellant respectfully requests that the rejection of claims under 35 U.S.C. §101 be reversed.

"A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *In re Bilski*, 545 F.3d 943, 954, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008).

The claims of the application are directed to a "system," which is known to be either a machine or apparatus, but not a process. The system is recited as part of a computer network used for planning and tracking certification. Thus, the preamble of the claimed invention alone recites two structures, namely a system and a network. Another structural limitation of the claimed invention is "a database" that among other things stores profiles, namely user and authority profiles.

The Official/Advisory Action states that the claimed "planner and tracker is[sic] not recited as having any corresponding structure." The Official Action gives "broadest reasonable interpretation" to these limitations and construes them as "nothing more than software." (See, Official Action, item 4) However, the specification shows the tracker in FIG. 2, and states "The certification goal planning system 202 can be implemented on one or more servers 10 or a central station. The system 202 has a planning module 204 and a tracking module 206." (See, specification, paragraph 39) FIG. 13 shows Certification Planner page and FIG. 14 shows a Certification tracker page, which according to the claimed invention are generated by executing the planning and tracking modules at one or more workstations within the network. According to the specification workstations are defined as devices, not limited to "personal computers, mobile computers, notebooks, workstations, etc., which operate under any workstation operating system, e.g., Windows or Mac OS operating systems." See *Paragraph 32*. Thus, execution of the planning and tracking modules at one or more workstations further ties the claimed invention to a machine or apparatus, as required under *Bilski*, thereby meeting the requirements of 35 U.S.C. §101. Therefore, Appellant respectfully requests that the rejection of claims under 35 U.S.C. §101 be reversed and such claims be allowed as patentable.

B. The rejection of claims 1-7, 9-11, 13 and 14 as being unpatentable over Wenger in view of L'Allier et al.

Appellant argues that the rejection of claims 1-7, 9-11, 13 and 14 as being unpatentable over Wenger in view of L'Allier, in the Official/Advisory Action is incorrect and that these claims should be allowed.

1. Argument for Independent Claim 1:

Claim 1 is directed to a system that is accessible by at least one user over a computer network for planning and tracking certification. A database stores at least one user profile and at least one authority profile. A user profile specifies user information including a certification authority. An authority profile contains one or more certification requirements associated with the certification authority specified in the user profile. A planning module executed at one or more workstations generates one or more certification goals based on the user profile and authority profile. Claim 1 requires the planning module to be responsive to a user's selection of certification goals to create a certification plan. Claim 1 also requires the planning module to transmit the certification plan to the certification authority specified in the user profile. A tracking module executed at a workstation updates the certification plan in response to input regarding achievement of the one or more user-selected certification goals.

As amended and entered, the first limitation in the body of claim 1 requires "a database" that stores at least one "user profile" and at least one "authority profile," where the user profile specifies user information including a certification authority and the authority profile contains one or more certification requirements associated with the certification authority specified in the user profile. The Official/Advisory Action wholly ignores this first limitation, which requires specifying a certification authority in the user profile, and proceeds to the second claimed requirement, namely, the "planner module." For this claimed requirement, which requires generating "one or more certification goals based on the user profile, which specifies the certification authority, and the authority profile", the Official/Advisory Action cites paragraph 89 of Wegner and states that "users

select the school they want to profile their transcript against. The analysis provides a profile that details overall credits required to complete the program, where transcript information is stored in the users profile/account and the program information is taken from school profiles and the credits to be competed for the program are the certification goals." (See, 3rd Paragraph of the Official Action).

Wegner discloses a method and system for auditing academic credit for employment and training. (See, Wegner's Title). More specifically, the disclosed method and system provides credit auditing and record keeping services to assist individuals with identifying career opportunities and analyzing their credit during career planning so that employment experience and training is valued in terms of "academic credit." (See, Wegner Abstract). The method and system of Wegner audits personal transcripts and employment records against credits or program requirements of a school and provides a report. A Credit Tracking function in Wegner tracks what kind of credit was granted or could be granted by a partner school. A Database of Equivalencies is created and maintained for each partner school. A Career Planning System includes a career plan and reports for employment. The Career Planning System is linked to a training subsystems and tracks credits achieved through training or Portfolio processes. (See, Paragraphs 30 and 31).

The Official/Advisory Action, however, fails to specify how "users profile/account" of Wegner, which store the users' transcripts' also specify the "school they want to profile their transcript against," there is no teaching or suggestion in Wegner for specifying in the user profile the certification authority referenced in the authority profile. It is likely that the transcripts of Wegner specify corresponding schools, but the specified schools are not the same as the ones the users want to profile their transcripts against. This is because if they were, there would be no need for such

profiling. Indeed, claim 1 requires the planning module to transmit the certification plan to the certification authority specified in the user profile. Even assuming arguendo that "the credits to be competed" in Wegner are the certification goals, as suggested by the Official/Advisory Action, there is still no teaching or suggestion in Wegner that a plan based on these goals is transmitted to the school that the users want to profile their transcript against.

The Official/Advisory Action concedes that Wenger fails to explicitly disclose the claim requirement that "the planner is responsive to user selection of one or more of the generated certification goals for creating a certification plan". (See, 5th Paragraph of the Official Action) The Official/Advisory Action states that L'Allier discloses an automated system and method for creating an individualized learning program having a planner to generate a training regimen responsive to user selection of one or more of the generated training goals. Citing column 6, lines 6-14 of L'Allier, the Action states that "a user identifying a skill desired and generating a training regimen based on that desired skill not currently possessed by the user, where the skill is the training goal." (See, 6th Paragraph of the Official Action). The Official/Advisory Action concludes that it would have been obvious to modify the method and system for auditing academic credit for employment and training of Wenger to include the generation of a training regimen based on a selected desired skill as taught by L'Allier in order to tailor a program directly to those skills that the user needs or desires." (See, 7th Paragraph of the Official Action)

L'Allier discloses an automated system and method for creating an individualized learning program. (See, L'Allier's Title) The disclosed system and method identify a "gap" between the skill(s) possessed by the individual and those required by an organization and then creates a training

regimen to fill that gap. The system and method precisely map the training to the defined required skills by identifying a skill desired to be possessed of a user and accessing a first electronic database that comprises a set of skills currently possessed by the user. Next the desired skill is compared with the possessed set of skills. If the possessed set of skills does not include the desired skill, the desired skill is mapped with a training regimen resident in a second electronic database. Then the user is automatically presented with the training regimen. A desired skill level may also be also specified and compared with the skill level currently possessed by the user. If the desired skill level has not yet been achieved, again a mapping is performed and a linked training regimen presented to the user. (See, L'Allier's Abstract)

Even assuming *arguendo* that Wegner and L'Allier can be combined, such combination would result in a system and method that analyses users' transcripts and identifies "gaps" between the skill(s) possessed by the users and those required by a school, as set forth in Wegner's Database of Equivalencies to create a training regimen to fill that gap by mapping the required skill with the training regimen. It is respectfully submitted that the system and method for creating an individualized learning program as disclosed in L'Allier is automated, as specified in the Title, by the disclosed mapping function. In contrast, the present invention requires the planner to be responsive to user selection of one or more of the generated certification goals for creating a certification plan. The automated mapping function disclosed in L'Allier for creating the user's training regimen, which by definition does not require any user selection, is opposite the claimed requirement for user selection of one or more of the generated certification goals for creating a certification plan..

The Official/Advisory Action cites column 6, line 6-14 of L'Allier, which states:

"FIG. 2A is a flow diagram of the method 40 for creating an individual development plan. In this aspect of the method the organization, typically by way of a supervisor or manager, identifies a skill and skill level desired to be possessed by the user 401. The system 10 then accesses the skills database 402 and retrieves the user's skills and skill levels 403."

As best understood, the Action equates the identification by a supervisor or manager of an organization of skills/skill level desired to be possessed with the claimed requirement for "the user selection of one or more of the generated certification goals for creating a certification plan." First of all, identification of user skills by a supervisor is not the same as selection of certification goals by the user for creating the certification plan. In other words, L'Allier teaches the manager or supervisor creating the training plan, not the user for which the training plan is automatically created without any user interaction or selection. Claim 1 requires the user to select the certification goals not a supervisor or manager. Moreover, claim 1 requires the user to use the planner to select the certification goals. There is no teaching or suggestion in L'Allier that the users use any interactive planner since the training regiment is created automatically by the disclosed mapping function.

Based on the foregoing, it is respectfully submitted that the combination of Wegner and L'Allier as suggested by the Official/Advisory Action fails to teach each and every one of the claimed limitations, namely:

- 1) a user profile that specifies a certification authority,

2) an authority profile that is associated with the certification authority specified in the user profile;

3) a planning module that responds to a user's selection of one or more certification goals to create a certification plan; and

4) a planning module that transmits the certification plan to the certification authority specified in the user profile.

2. Argument for Claims 2-7, 9-11, 13 and 14:

Claims 2-7, 9-11, 13 and 14 are patentable over the combined teachings of Wenger and L'Allier for at least the same reasons as claim 1 from which they depend. Therefore, Appellant respectfully requests that the rejection of claims 2-7, 9-11, 13 and 14 under 35 U.S.C. §103(a) be reversed and that claims 2-7, 9-11, 13 and 14 be allowed.

C. The rejection of claims 8, 15 and 16 as being unpatentable over Wenger in view of L'Allier and in further view of Orton et al.

Appellant argues that the rejection of claims 8, 15 and 16 as being unpatentable over Wenger and L'Allier in further view of Orton, indicated in item 7 of the Official Action is incorrect and that these claims should be allowed.

For the reasons presented above, claim 1 is patentable over the combination of Wenger and L'Allier. Claim 8 recites the planning module prioritizing “the generated certification goals based on the one or more certification requirements of the certification authority.” Claim 15 recites the tracking module transmitting “an e-mail to the user in connection with a certification goal.” Claim

16 recites the tracking module alerting “the user regarding a certification goal deadline.” Because claim 1 is patentable, the further limitations recited in claims 8, 15 and 16, all of which depend on claim 1, are patentable for at least the same reasons. Therefore, Appellant respectfully requests that the rejection of claims 8, 15 and 16 under 35 U.S.C. §103(a) be reversed and that claims 8, 15 and 16 be allowed as patentable.

D. The rejection of claims 17 and 18 as being unpatentable over Wenger in view of L’Allier and in further view of Finaid.org.

Appellant argues that the rejection of claims 17 and 18 as being unpatentable over Wenger and L’Allier in further view of Finaid.org, indicated in item 8 of the Official Action is incorrect and that these claims should be allowed.

For the reasons presented above, claim 1 is patentable over the combination of Wenger and L’Allier. Claims 17 and 18 recite an on-line grant module “accessible by the user to search for a grant” and that “allows the user to apply for a selected grant,” respectively. Because claim 1 is patentable, the further limitations recited in claims 17 and 18 are patentable for at least the same reasons. Therefore, Appellant respectfully requests that the rejection of claims 17 and 18 under 35 U.S.C. §103(a) be reversed and that claims 17 and 18 be allowed as patentable.

E. The rejection of claim 12 as being unpatentable over Wenger in view of L'Allier and in further view of Examiner's Official Notice.

Appellant argues that the rejection of claim 12 as being unpatentable over Wenger and L'Allier in further view of the Examiner's Official Notice, indicated in item 9 of the Official Action is incorrect and that these claims should be allowed.

For the reasons presented above, claim 1 is patentable over the combination of Wenger and L'Allier. Claim 12 recites the course of claim 11 comprising "at least one of a live course and a self-paced course." Because claim 1 is patentable, the further limitation recited in claim 12 is patentable for at least the same reasons. Therefore, Appellant respectfully requests that the rejection of claim 12 under 35 U.S.C. §103(a) be reversed and that claim 12 be allowed as patentable.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Applicant on March 9, 2009.

IX. CONCLUSION

For the foregoing reasons, it is respectfully submitted that independent claim 1 and its dependent claims 2-13 and 15-18 are patentable over Wenger and L'Allier either alone or in combination with Orton, Finaid.org or the Examiner's Official Notice. Accordingly, Appellant respectfully requests that the Examiner's rejections of claims 1-13 and 15-18 be reversed and that these claims be allowed as patentable.

Dated: June 9, 2009

Respectfully submitted,

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/715,137

1. (Previously Presented) A system accessible by at least one user over a computer network for planning and tracking certification, comprising:

a database storing at least one user profile and at least one authority profile, wherein the at least one user profile specifies user information including a certification authority, and wherein the at least one authority profile contains one or more certification requirements associated with the certification authority specified in the user profile;

a planning module executed at one or more workstations that generates one or more certification goals based on the at least one user profile and the at least one authority profile, wherein the planning module responds to the at least one user's selection of the one or more certification goals to create a certification plan and wherein the planning module transmits the certification plan to the certification authority specified in the user profile; and

a tracking module executed at one or more workstations that updates the certification plan in response to input regarding achievement of the one or more user-selected certification goals.

2. (Previously Presented) The system of claim 1, wherein the certification plan relates to at least one of certification, re-certification, licensing, re-licensing in a field of endeavor.

3. (Previously Presented) The system of claim 2, wherein the field of endeavor comprises a field relating to at least one of education, teaching, medical, engineering, legal, accounting, and sports.
4. (Original) The system of claim 1, wherein the certification authority comprises at least one of a federal government, state government, county government, local government, municipal government, public official, private official, governmental agency, non-governmental agency, public institution, and private institution.
5. (Previously Presented) The system of claim 1, wherein the planning module is responsive to at least one of Needs Assessment and Certification Credit information for generating the certification.
6. (Previously Presented) The system of claim 1, wherein the planning module is responsive to certification credit transferred from another certification authority for generating the certification goals.
7. (Previously Presented) The system of claim 1, wherein the tracking module updates the certification plan based on at least one of a user input and non-user input.
8. (Previously Presented) The system of claim 1, wherein the planning module prioritizes the generated certification goals based on the one or more certification requirements of the certification authority.

9. (Previously Presented) The system of claim 1, further including a certification resource generator that associates at least one of the certification goals with at least one certification resource.

10. (Previously Presented) The system of claim 9, wherein the at least one certification resource comprises at least one of a course, program, session, seminar, audio lecture, video lecture, a book, a test, and a form.

11. (Previously Presented) The system of claim 9, wherein the at least one certification resource has a format comprising at least one of a course, session, seminar, degree program, test, form, book, audio, and video.

12. (Previously Presented) The system of claim 11, wherein the course comprises at least one of a live course and a self-paced course.

13. (Previously Presented) The system of claim 1, further including an on-line system accessible by the user for at least one of receiving, ordering, and registering for a certification resource.

14. (Cancelled)

15. (Previously Presented) The system of claim 1, wherein the tracking module transmits an e-mail to the user in connection with a certification goal.

16. (Previously Presented) The system of claim 1, wherein the tracking module alerts the user regarding a certification goal deadline.

17. (Original) The system of claim 1 further including an on-line grant module accessible by the user to search for a grant.

18. (Previously Presented) The system of claim 17, wherein the on-line grant module allows the user to apply for a selected grant.

APPENDIX B

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

APPENDIX C

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.

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